



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,104	07/19/2000	Daniel F.X. O'Reilly	NEWS-1	1014

7590

05/20/2003

Pandiscio & Pandiscio  
470 Totten Pond Road  
Waltham, MA 02451-1914

EXAMINER

ASSOUAD, PATRICK J

ART UNIT

PAPER NUMBER

2857

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/619,104

Applicant(s)

O'REILLY ET AL.

Examiner

Patrick J Assouad

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/1/03 has been entered.

***Response to Arguments***

2. Applicant's arguments filed 4/1/03 have been fully considered but they are not persuasive. Applicant has amended the preambles of independent claims 1 and 28 to now include "related to at least one news source"; however, there is no nexus between the preambles and the bodies of these independent claims. Consequently, this new limitation in the preamble of these claims does not "give life, meaning, and vitality" to the claims. See MPEP 2111.02.

3. The Examiner believes that the news statistics of both **Reilly et al.** and **Herz et al.** include both *subjects* of news articles and *source(s)* of news articles. The terms *subjects* and *sources* are broadly but reasonably interpreted. MPEP 2111. See at least Figs. 4-6 and 8 of **Reilly et al.** for news categories, news subcategories, news headlines, and of course, various time-stamped news stories. See at least Figs. 5 and 10 of **Herz et al.** for "document activity" and the "monitor[ing of] which articles are read".

Art Unit: 2857

With respect to "news source[s]", see at least Figure 1 of **Reilly et al.** which clearly shows: "AP News Feed, DOW News Feed, Sports Ticker ...", which are of course, news sources being fed to the Newswire Interface 120.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Reilly et al.** ('549) in view of **Herz et al.** ('939).

6. Fig 1 of **Reilly et al.** and Fig. 10 of **Herz et al.** are reproduced below.

7. **Reilly et al.** disclose an information and advertising distribution system and method. **Reilly et al.** substantially disclose the instant claimed method and apparatus. More particularly, they disclose in col. 9 that their "display statistics generator 210 keeps track of how many times each news item has been displayed in the same time period. These display statistics are stored in the user profile 194 at 218...news items display statistics are transferred to the information server once per day during a connection..."

Art Unit: 2857

8. The difference between the instant claimed invention and that of **Reilly et al.** lies in the “signaling when the comparison yields a difference greater than a predetermined amount”.

9. **Herz et al.** disclose a system for generation of user profiles for a system for customized electronic identification of desirable objects. They particularly teach that information related to an online user's particular interests and activities is of very special interest to marketers and advertisers. Demographic analysis and market research of user profiles can be used to match target objects to users more readily. Newspaper stories are merely one element of a user's particular profile. See at least cols. 5-7 of **Herz et al.** How often a particular subject or article of a particular newspaper or novel is read is a good indicator of its popularity. According to **Herz et al.** each user's profile interest summary is “automatically updated on a continuing basis to reflect the user's changing interests” (col. 6). Such updating is associated by the Examiner with the claimed “signaling”. See at least Fig. 10 of **Herz et al.**

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the “automatic updates to reflect the user's changing interests” as taught by **Herz et al.** into the information distribution system of **Reilly et al.** because such a system provides almost instantaneous market research data that can be exploited to match numerous products and services to a particular user's measurable interests.

11. With respect to dependent claims 2-27, the Applicant is urged to closely review at least Figs. 1, 4 and 5 of **Reilly et al.** which clearly show the various claimed client/server relationships, the various databases/news sources, and the various statistics and timestamps.

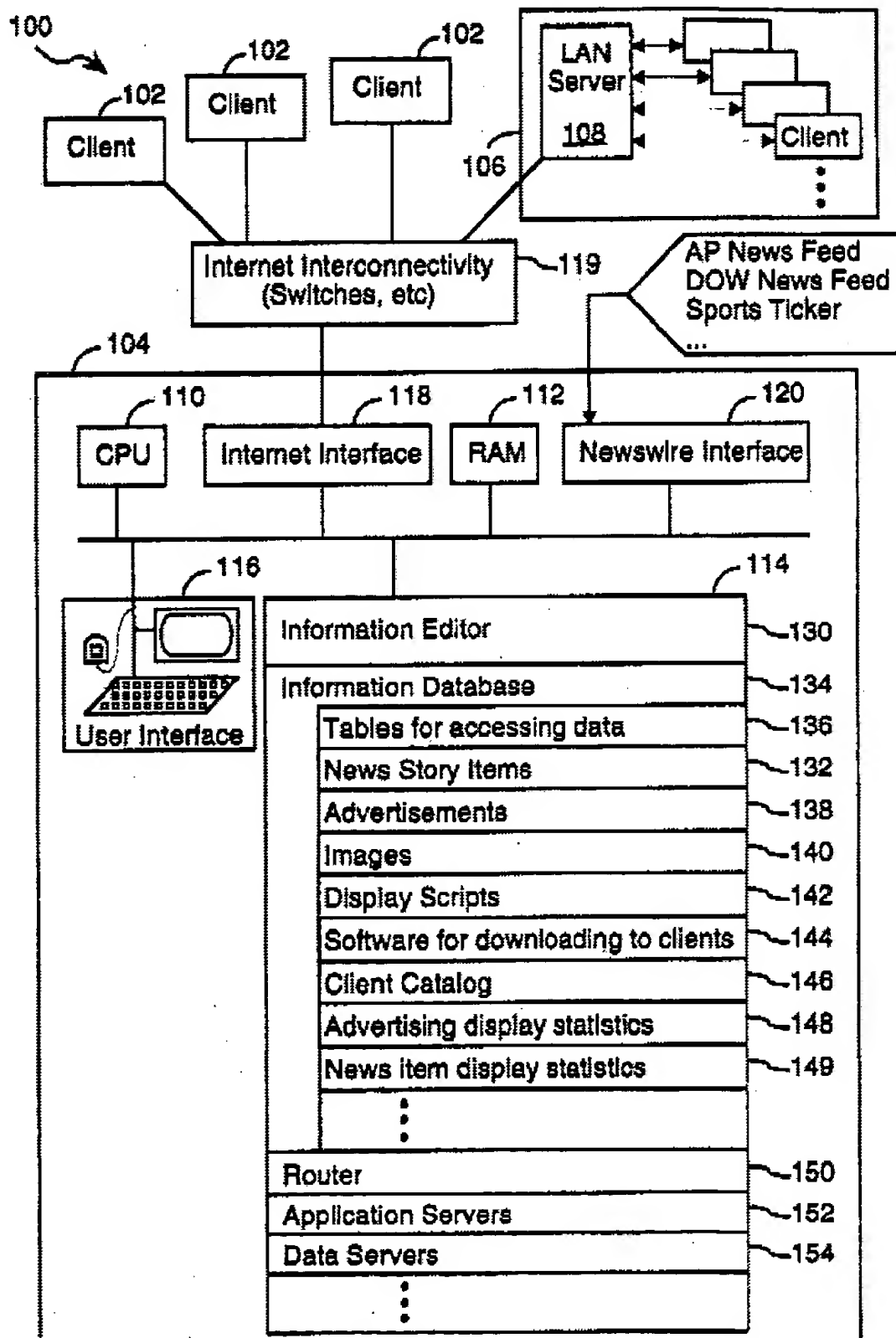
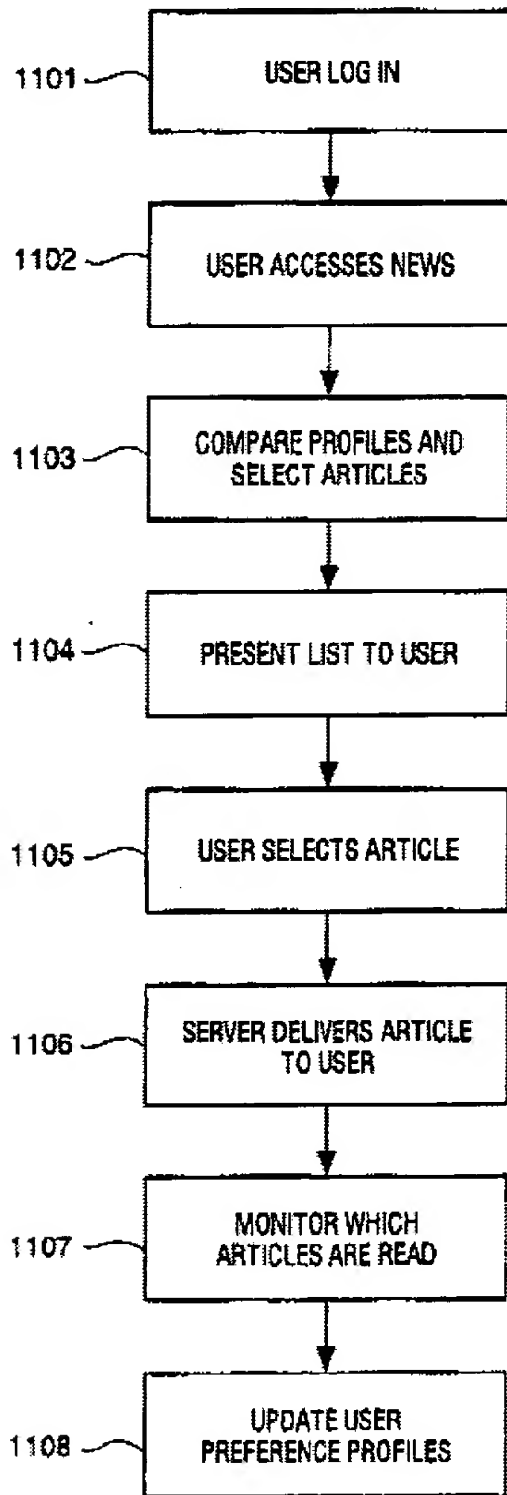


FIGURE 1



**FIG. 10**



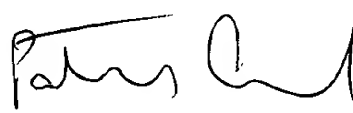
Art Unit: 2857

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J Assouad whose telephone number is 703-305-3811. The examiner can normally be reached on Tuesday-Friday, 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 703-308-1677. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Patrick J Assouad  
Primary Examiner  
Art Unit 2857

PJA  
May 14, 2003